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10/539,330	06/15/2005	Declan P. Kelly	NL021460	9273
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/539,330

Applicant(s)

KELLY ET AL.

Examiner

DUNG LAM

Art Unit

2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 5/2/08.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 June 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CD/CD)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

1. **Claims 1, 20-26, and 32** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Yamanaka et al.** (US Patent Application Publication 2001/0016834) in view of **Brown et al** (US Pub No. 2003/0046548).

Consider **claims 1, 20-26, and 32**, Yamanaka et al. discloses a method of enabling an electronic transaction (Abstract Fig. 25), the method comprising:

providing storable electronic content to a user (*Step ST161 Fig. 25, [0271]*),

providing an electronic application to the user that restricts user access to the storable electronic content (*Fig.3a&b, ST 161 Fig. 25, [16, 0271]*); and

subsequent to the user being provided with the storable electronic content, providing electronic advertising content to the user, the electronic advertising content comprising control commands (execution key [027]) that are receivable from a party other than the user the control commands are generated upon the user selecting ... the electronic advertising electronic application to render the electronic content accessible to the user (ST167 [0016, 0273]). The examiner notes that the act of selecting the ads tells the system that the user implicitly commands the system to play the advertisement.

However, **Yamanaka** does not explicitly teach the user playing the electronic advertising content. In an analogous art of advertising, **Brown** teaches that the user must view/play the advertisements content in order to access the electronic content (read the electronic mail messages, [113]). Therefore, it would have been obvious for one skill in the art at the time of the invention to combine Yamanaka's teaching with Brown's teaching of imposing the user to view the ads prior to rendering the free service to maximize the exposure of the ads.

2. **Claims 2, 11, 14-17, 27-28** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Yamanaka et al.** (US Patent Application Publication 2001/0016834) in view of **Brown et al** (US Pub No. 2003/0046548) in view of **Wu** (US Pat No. 6874018) .

Consider **claim 2**, as applied to claim 1 above, **Yamanaka et al.** as modified by **Brown et al.** further discloses that the storable electronic content and the electronic application are stored on a communication device, and wherein providing the control commands comprises: connecting the communication device to a server; and transmitting the control commands from the server to the communication device ([0016-0018], fig. 3A and 25; device has to be connected to server to receive the execution permission). However, they do not specifically teach that the device is a wireless device. In an analogous art, Wu teaches the concept of sending advertisements to a handheld wireless device (Abstract). Therefore, it would have been obvious for one of ordinary skill in the art at the time of the invention to applied the combined teaching teaching of Yamanaka and Brown's teaching to the wireless device as taught by Wu because implementing the concept of advertising to the wireless arena would increase the ads effectiveness or exposure tremendously because there is a large growth in wireless device usage

Consider **claims 11, 14, and 27-28**, as applied to claims 1 and 20 above, **Yamanaka et al.** as modified by **Brown et al.** disclose that the electronic advertising content is provided together with the electronic content as is renderable by the electronic application ([16-17, 0273]).

Consider **claim 15**, as applied to claim 11 above, **Yamanaka et al.** as modified by **Brown et al.** and further by **Wu** further teaches connecting the portable wireless device to a server (16, 273); transmitting the control commands and the identified electronic advertising from the server

to the portable wireless device ([0273]). However, they fail to teaches the use of geographic information to determine which ads are pertinent to be sent. However, it is well known in the of advertising to determine the location or user profile of the user in determining which ads are relevant or might be of interest to the user. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to incorporate these further teachings of Yamanaka et al. in order to provide the most appropriate advertising for the user.

Consider **claim 16**, as applied to claim 1 above, Yamanaka et al. as modified by Yamanaka et al. further discloses that the control commands control at least a selection of the electronic content (*Fig 26*).

Consider **claim 17**, as applied to claim 1 above, Yamanaka et al. as modified by Yamanaka et al. further discloses that the electronic content is at least audio ([002,004,129]).

3. **Claims 3-4, 6-8, 10, 29-31, and 34** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Yamanaka, Brown and Wu** further in view of **Lamkin et al. (US Patent Application Publication 2004/0220926)**.

Consider **claims 3 and 29-31**, as applied to claim 2 and 20 above, Yamanaka et al. as modified by Yamanaka et al. discloses a portable wireless device that receives electronic content and control commands in order to render content, but does not specifically require the commands to be sent every time the content is to be rendered for playback. Yamanaka et al. discloses that the procedure of receiving the execution key can be performed repeatedly (*Page 7, Paragraph 0019*), but fails to specifically disclose that it is every time or that a count is maintained.

In related art, Lamkin et al. discloses a method wherein the control commands are separately transmitted each time the electronic application renders the electronic content

accessible to the user (*read as the access rights manager 482, which performs e-commerce transactions through the content acquisition agent 472, may be required to obtain or validate licenses for entities before allowing playback each time – Figure 4 – Pages 17-18, Paragraphs 240-241*), the method comprising maintaining a count of a number of times that the control commands are transmitted to the portable wireless device (*usage counts are maintained in the metadata – Page 17, Paragraph 239; additionally the user may only be granted for a given number of these usage counts, and each time the file is accessed the usage count is decremented, Page 18, Paragraph 241*).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to incorporate the teachings of Lamkin et al. with those of Yamanaka et al. as modified by Yamanaka et al. in order to further control the distribution of content to wireless communication devices. This employs digital rights management, which protects the copyrights of media, to be applied to content, be it promotional or other secure distribution, supplied to a wireless communication device user.

Consider **claim 4**, as applied to claim 3 above, Yamanaka et al. as modified by Yamanaka et al. and further by Lamkin et al. further discloses denying the transmittal of the control commands if the count exceeds a given number (*Lamkin et al. – the file is no longer usable once the usage count is exceeded – Page 18, Paragraph 241*).

Consider **claim 6**, as applied to claim 2 above, Yamanaka et al. as modified by Yamanaka et al. fails to disclose that the server receives a user identification each time the portable wireless device is connected to the server.

In related art, Lamkin et al. discloses that a user identification is received at the server each time the portable wireless device is connected and maintaining a count of a number of times the user identification is received from the user (*read as when the device is logged in the user is required to log in in order to provide identification, – Page 38, Paragraph 561*).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to incorporate the teachings of Lamkin et al. with those of Yamanaka et al. as modified by Yamanaka et al. in order to be able to monitor when a user is online and to provide security to the network and track usage since all active users can be monitored.

Consider **claims 7 and 34**, as applied to claims 2 and 20 above, Yamanaka, Brown and Wudiscloses that the electronic content contains a plurality of electronic content portions which require control commands to be supplied before are rendered but fails to specifically disclose that the control commands are required each time and the counting of these command transmissions. Yamanaka et al. discloses that the procedure of receiving the execution key can be performed repeatedly (*Page 7, Paragraph 0019*), but fails to specifically disclose that it is every time or that a count is maintained.

In related art, Lamkin et al. discloses that the electronic content contains a plurality of content portions (*read as the media can be audio, video, documents, etc. and in the instance when it is a movie, some scenes may selectively have different access rights – Page 18, Paragraph 241 and Page 34, paragraph 513*), transmitting a control command in response to a request from the user containing a user identification (*user is required to log in in order to provide identification – Page 38, Paragraph 561*) wherein the request is for the control command (*read as the access rights manager 482, which performs e-commerce transactions*

through the content acquisition agent 472, may be required to obtain or validate licenses for entities before allowing playback each time – Figure 4 – Pages 17-18, Paragraphs 240-241), and maintaining a count of a number of times that the control commands are transmitted to the portable wireless device (usage counts are maintained in the metadata – Page 17, Paragraph 239; additionally the user may only be granted for a given number of these usage counts, and each time the file is accessed the usage count is decremented – Page 18, Paragraph 241).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to incorporate the teachings of Lamkin et al. with those of Yamanaka, Brown and Wu in order to have more control over the provisioned content, allowing the content to be used in a more effective manner for individual situations.

Consider **claim 8**, as applied to claim 7 above, Yamanaka, Brown and Wu and further by Lamkin et al. discloses providing unrequested keys determined from the count (*Page 12, Paragraph 0152*).

Consider **claim 10**, as applied to claim 1 above, Yamanaka, Brown and Wu discloses that the electronic content contains a plurality of content portions and wherein a corresponding control command is required to be provided before the electronic application renders one of the plurality of electronic content portions, but fails to disclose that this control command is separately required before each rendering of the content. Yamanaka et al. discloses that the procedure of receiving the execution key can be performed repeatedly (*Page 7, Paragraph 0019*), but fails to specifically disclose that it is every time or that a count is maintained.

In related art, Lamkin et al. discloses that the electronic content contains a plurality of content portions (*read as the media can be audio, video, documents, etc. and in the instance*

when it is a movie, some scenes may selectively have different access rights – Page 18, Paragraph 241 and Page 34, paragraph 513) and wherein a corresponding control command is required to be separately provided each time the electronic application renders one of the plurality of electronic content portions (read as the access rights manager 482, which performs e-commerce transactions through the content acquisition agent 472, may be required to obtain or validate licenses for entities before allowing playback each time – Figure 4 – Pages 17-18, Paragraphs 240-241).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to incorporate the teachings of Lamkin et al. with those of Yamanaka, Brown and Wu in order to have more control over the provisioned content, allowing the content to be used in a more effective manner for individual situations.

4. **Claims 12-13 and 18-19** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Yamanaka, Brown, and Wu** further in view of **Donian et al. (US Patent Application Publication 2004/0003398)**.

Consider **claim 18**, Yamanaka et al. discloses a method of enabling an electronic transaction, the method comprising the acts of:

providing storable electronic content to a user (*removable data carrier 83 – Figures 6 and 7 – Abstract; Page 5, Paragraph 0068*);

providing an electronic application to the user that restricts user access to the storable electronic content (*access to the inserted media is restricted – Abstract; Page 5, Paragraphs 0060-0061 and 0064*);

subsequent to the user being provided with the storable electronic content, providing content comprising control commands that are receivable from a party that desires the determined electronic advertising be provided to the user, the operation of the control commands enabling the electronic application to render the electronic content accessible to the user (*the user requests to access the content from the removable media, but must acquire appropriate authorization from a server to render the content accessible – Page 4, Paragraphs 0045-0050; Page 5, Paragraphs 0060-0061 and 0064*).

However, while Yamanaka et al. disclose the act of providing access to content provided to a user upon appropriate interaction with a system other than the user by receiving a message containing control commands, they fail to disclose that the control commands are received as electronic advertising content comprising the control commands.

In related prior art, Yamanaka et al. disclose storing of content on a user's device and activating that content based upon advertisements comprising control commands (*the content is stored on the device and in order to activate the content, the user contacts an external source which supplies advertisements containing execution keys which activate the stored content – Figures 4-6 – Abstract; Page 1, Paragraphs 0010-0016; Page 6, Paragraphs 0117-0118; Page 7, Paragraphs 0118-0127; along with multiple other examples, the previous is shown as a representative citation for the abilities of the reference*).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to incorporate the teachings of Yamanaka et al. with those of Yamanaka et

al. because it is desirable to provide a minimally intrusive way to present preloaded and initially restricted information when a control command is received.

However, Yamanaka, Brown and Wufails to disclose the determination and provision of electronic advertising based on a personal profile. Yamanaka et al. discloses that the user can select an interest area to receive pertinent advertisements (*Page 3, Paragraphs 0040-0046; Page 16, Paragraphs 0262-0265*), but they fail to specifically disclose maintaining a personal profile.

In related prior art, Donian et al. discloses the determination of electronic advertising based on a personal profile (*preference parameters 678 – Page 18, Paragraph 223*). Donian et al. also teaches that once appropriate advertising is selected, it is transmitted to the user (*Pages 3-4, Paragraphs 49 and 55 – using the intersplicer 518 which initializes settings 782 that can control how the playback proceeds and prepares all of the content that is ordered by the user – Page 18, Paragraph 230*).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to incorporate the teachings of Donian et al. with those of Yamanaka, Brown and Wu in order to provide more appropriate advertising with the requested media to the end-user so they are not presented irrelevant information which may discourage them from returning to the service.

Consider **claim 19**, as applied to claim 18 above, Yamanaka, Brown and Wu and further by Donian et al. fails to teach the acts of monitoring the user selection of electronic content and providing an update to the personal profile based on a result of the monitoring.

However, Donian et al. further teaches the acts of:

monitoring user selection of content (*read as the intersplicer 518 keeps an account of which ads have been seen, advertisements which have been selected based on content – Page 19, Paragraph 239*); and

providing an update to the personal profile based on a result of the monitoring (*read as the intersplicer can select new advertisements to present to the user in the case that a particular advertisement has already been seen – Page 19, Paragraph 239*).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to incorporate the teachings of Donian et al. with those of Yamanaka, Brown and Wu so that the same advertisement is not repeatedly provided to the consumer, to maximize the effect of the advertising.

Consider **claims 12 and 13**, as applied to claim 11 above, Yamanaka, Brown and Wu teach that the electronic application renders the electronic content accessible to the user but fails to disclose that the electronic advertising content in a determined order.

In related prior art, Donian et al. discloses that the electronic advertising content in a determined order (*Donian et al. – read as the appropriate demand determines when the advertising is placed into the media – Page 4, Paragraph 55 – and the intersplicer 518 initializes settings 782 which can control how the playback proceeds – Page 18, Paragraph 230*).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to incorporate the teachings of Donian et al. with those of Yamanaka, Brown and Wu in order to provide the advertising content when it is most relevant.

5. **Claim 9** is rejected under 35 U.S.C. 103(a) as being unpatentable over **Yamanaka, Brown and Wu** in view of **Lamkin et al. (US Patent Application Publication 2004/0220926)**, further in view of **Donian et al. (US Patent Application Publication 2004/0003398)**.

Consider **claim 9**, as applied to claim 7 above, Yamanaka, Brown and Wu and further by Lamkin et al. discloses the act of providing electronic advertising content renderable by the electronic application, but fails to disclose that this information is determined from the count.

In related prior art, Donian et al. discloses the act of selecting advertising content based on monitoring user selection of content (*read as the intersplicer 518 keeps an account of which ads have been seen, advertisements which have been selected based on content – Page 19, Paragraph 239*) and providing an update to the personal profile based on a result of the monitoring (*read as the intersplicer can select new advertisements to present to the user in the case that a particular advertisement has already been seen – Page 19, Paragraph 239*).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to incorporate the teachings of Donian et al. with those of Yamanaka, Brown and Wu and further by Lamkin et al. so that the same advertisement is not repeatedly provided to the consumer, to maximize the effect of the advertising.

6. **Claims 5 and 33** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Yamanaka, Brown and Wu** in view of **Ochiyama et al. (US Patent Application Publication 2004/0031377)**.

Consider **claims 5 and 33**, as applied to claims 2 and 20 above, Yamanaka, Brown and Wu fails to disclose that the electronic application can only render the electronic content when connected to the server.

In related art, Ochiyama et al. discloses that the electronic application is only able to render the electronic content while the portable wireless device is connected to the server (*read as the TOC information is sent to the portable phone device 200 – Page 12, Paragraph 162*).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to incorporate the teachings of Ochiyama et al. with those of Yamanaka, Brown and Wu in order to only allow content to be rendered while connected to a server, allowing only the most up to date information to be displayed, rather than information stored on the phone or media and to allow for further controlled management of distributed content.

Response to Amendment

Applicant's arguments with respect to claims 1-34 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Harper can be reached on (571) 272-7605. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/VINCENT P. HARPER/
Supervisory Patent Examiner, Art Unit 2617